

Application No.: 10/599584
Filing Date: October 18, 2007

REMARKS

By way of summary, Claims 1-18 were pending in the present application. In this Response, Claims 2-5, 7-16, and 18 have been amended, Claims 6 and 17 have been canceled, and Claims 20-29 have been added. Accordingly, Claims 1-5, 7-16, 18, and 20-29 are pending for consideration.

The Specification

The Office Action stated that a new title is required that is clearly indicative of the invention to which the claims are directed. Applicants respectfully traverse this rejection. However, in order to advance prosecution, Applicants have amended the title. The title is considered to be non-limiting. The title has been amended herein to “Scope Warming Device with Whitening Element,” and Applicants submit that no new matter is introduced by way of this amendment.

Objection to the Drawings

The Office Action objected to the drawings as not showing the plurality of steps recited in Claim 6 and the handle clip recited in Claim 17. Applicants traverse this rejection, but have canceled Claims 6 and 17 herein without prejudice or disclaimer in order to advance prosecution, and therefore request that the Examiner withdraw the drawing objections. Applicants reserve the right to pursue the subject matter of Claims 6 and 17 at a later date.

Claim Objections

The Office Action objected to minor informalities in the claims, specifically: in Claim 2, line 8, “siad” should be “said;” Claim 2, line 11 is missing a period after “layer;” and Claim 15, line 2 contains an errant “1” after “wherein said.” Those informalities have been corrected in the amended claims presented above. Accordingly, Applicants respectfully request withdrawal of the objections to the claims.

35 U.S.C. §112, ¶ 1 Rejection of Claim 10

The Office Action rejected Claim 10 under 35 U.S.C. § 112, first paragraph, because the “specification makes no mention of the claim materials that make up the whitening element.” Applicants traverse this rejection because Claim 10 was part of the original filing of this application and is therefore self-supporting under 35 U.S.C. § 112, first paragraph. *See* MPEP § 2163. Nevertheless, Applicants have amended the specification to include the claimed subject matter in accordance with MPEP § 2163.06. Furthermore, the subject matter of Claim 10 was disclosed in the foreign priority application, which was present on the filing date of the U.S. application.

35 U.S.C. §112, ¶ 2 Rejections of Claims 2-18

The Office Action rejected Claims 2-18 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claims 2, 13, and 18 were rejected for omitting the structural cooperative relationships between the heat conducting tube and heating element of Claim 1 and the recited structures of Claim 2. To clarify the claims, Claim 2 has been amended herein to recite “a double walled cylindrical tube forming part of said heat conducting tube” and “said heating element.” Claims 5, 8, 9, and 15 were rejected for lacking antecedent basis for certain claim limitations. Claims 5 and 15 have been amended to depend from Claim 2 and Claims 8 and 9 have been amended to depend from Claim 7 to provide antecedent basis for all claim limitations. Claim 6 was rejected because it was unclear whether “said tube” is the double walled cylindrical tube or the heat conducting tube. Claim 6 has been amended to recite “said double walled cylindrical tube.” Applicants therefore respectfully request withdrawal of the rejection of Claims 2-18 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. §102 Rejection of Claims 1, 3, 4, 7, 8, 10-12, and 14-17 over Beane

The Office Action rejected Claims 1, 3, 4, 7, 8, 10-12 and 14-17 under 35 U.S.C. § 102 as anticipated by Beane (US 2002/0022762). Applicants respectfully traverse this rejection because Beane fails to teach or suggest at least “a whitening element within or at the distal end of said tube that enables white balancing of said optical instrument” as recited in Claim 1.

Page 8, lines 21-25 of the present application as filed explain that “the light emanating from around the distal portion of the optical instrument 1 strikes the whitening insert 26 and is reflected back into the lens portion 2 enabling the equipment to be calibrated to ensure bodily tissue appears the correct colour on insertion of the distal portion of the optical instrument 1 into the body cavity.” The Office Action asserts that element 116 of Beane is a whitening element and states that white balancing “is considered inherently capable of being done with element 116.” However, element 116 is a sponge that “can be, e.g., porous polyethylene, urea formaldehyde, or other suitable porous material. Alternatively, sponge 116 can be replaced by other types of cleaning members, including other absorbent materials, such as cotton, or a jet spray system.” Beane, paragraph [0061]. As discussed during the May 26 interview, white balancing requires a relatively smooth surface to consistently reflect light back into the instrument lens. A sponge or other similar element cannot serve as a whitening element that enables white balancing of the optical instrument because the porous, uneven surface cannot properly reflect light back into the lens.

Claim 17 has been cancelled herein. Claims 3, 4, 7, 8, 10-12 and 14-16 are dependent claims that depend from independent Claim 1 and include at least all of the limitations of Claim 1 as well as the additional limitations recited therein. Therefore, Applicants respectfully request the rejections of Claims 1, 3, 4, 7, 8, 10-12 and 14-16 under 35 U.S.C. § 102 as anticipated by Beane be withdrawn for at least the reasons provided above.

35 U.S.C. §103(a) Rejection of Claims 2, 5, 6, 13, and 18 over Beane in view of Mukaida

The Office Action rejected Claims 2, 5, 6, 13, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Mukaida (US 6,789,644). Claim 6 has been canceled herein without prejudice or disclaimer. Claims 2, 5, 13, and 18 are dependent claims that depend from independent Claim 1 and include at least all of the limitations of Claim 1 as well as the additional limitations recited therein. Therefore, Applicants respectfully request the rejections of Claims 2, 5, 13, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Mukaida be withdrawn for at least the reasons provided above.

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35 U.S.C. §103(a) Rejection of Claim 9 over Beane in view of Agarwal

The Office Action rejected Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Agarwal (US 2003/0124277). Claim 9 is a dependent claim that depends from independent Claim 1 and includes at least all of the limitations of Claim 1 as well as the additional limitations recited therein. Therefore, Applicants respectfully request the rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Agarwal be withdrawn for at least the reasons provided above.

New Claims 20-29

New Claims 20-29 find support throughout the application as originally filed. Therefore, Applicants believe that no new matter is introduced with these claims. Furthermore, new Claim 20 recites, among other things, “a whitening element within or at the distal end of said tube-like structure, the whitening element usable to provide a basis for optical calibration of the optical instrument.” New Claim 26 recites, among other things, “calibrating said optical instrument while inserted in said device using a whitening element in the tube-like structure.” Therefore, Applicants submit that new Claims 20 and 26 are patentable over the applied art for at least reasons similar to those discussed above with respect to Claim 1. Claims 21-25 depend from independent Claim 20 and Claims 27-29 depend from independent Claim 26 and therefore include at least all of the limitations of the independent claims from which they depend, as well as the additional limitations recited therein. Therefore, Applicants submit that new Claims 20-29 are patentable over the applied art.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution.

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Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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